

REMARKS/ARGUMENTS

Claims 2-3 and 5-6 are cancelled.

Claims 10-24 are new.

Support for each new and amended claim is found at the originally filed claims and throughout the originally filed specification. Additionally, support for the feature of present Claim 1 “wherein the external preparation does not contain ethanol” is found, for example, MPEP 2173.05(i) combined with page 21, Table 1, of the originally filed specification. MPEP 2173.05(i) describes, in part, that “If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.” Table 1, page 21, of the originally filed specification, lists ethanol as an alternative element. Accordingly, ethanol can be excluded from the claims. Additionally, support for the Claim 1 feature “poultice or plaster” is found, for example, Example 11, pages 27-28 of the originally filed specification, and at Example 7, pages 24-25, of the originally filed specification. Support for the feature of present Claim 8 “with respect to the total amount of the external preparation” is found, of example, at page 7, last two lines – page 8, first three lines, of the originally filed specification. Support for the feature of present Claim 9 “with respect to the total amount of the external preparation” is found, for example, at page 11, second paragraph, of the originally filed specification. Support for Claims 20-23 is found, for example, at Example 11, pages 27-28, of the originally filed specification.

No new matter is believed to have been added.

Applicants than Examiners Chui and Haghghatian for the helpful and courteous interview of February 3, 2009, wherein amending the claims to exclude ethanol was discussed, and wherein the Examiners agreed this claim amendment would likely distinguish the claims from Katsuma.

The indefiniteness rejection of Claims 2 and 7-9 is respectfully traversed. The rejection of Claim 2 is obviated by cancellation of Claim 2. The rejection of Claims 7-9 is believed to be obviated by the amendment of Claims 1 and 7-9. Withdrawal of the rejection is respectfully requested.

The obviousness rejection of Claims 1-9 as being unpatentable in view of Katsuma is respectfully traversed because Katsuma does not describe or suggest all of the features of present Claim 1 and the claims depending therefrom, and because Katsuma “teaches away from” a feature of present Claim 1 and the claims depending therefrom.

The rejection of Claims 2-3 and 5-6 is obviated by cancellation of these claims.

Present Claim 1 contains the feature “wherein the external preparation does not contain ethanol.” Applicants submit Katsuma does not describe or suggest this feature and that Katsuma “teaches away from” this feature.

Katsuma, at the Abstract, describes, in part, “A medical composition for external use of O/W emulsion type which comprises...(d) aqueous ethanol.” Katsuma, at page 3, lines 49-52, describes, “The transdermal absorption preparation of the present invention is characterized in that the aforementioned terpenes are emulsified in aqueous ethanol, wherein the ethanol contained in the outer water layer is an essential composing element for sufficiently generating the absorption-enhancing effect of the aforementioned terpenes.”

Thus, Katsuma describes the presence of ethanol as being “essential.”

The essential nature of ethanol in Katsuma is further shown, for example, in Table 1 at page 8 of Katsuma, wherein all of the formulations (1-14) in Katsuma employ ethanol.

In contrast to Katsuma, the external preparation of present Claim 1 does not contain ethanol. Thus, Katsuma does not describe or suggest all of the features of present Claim 1

and the claims depending therefrom, and in fact, Katsuma “teaches away from” a feature of present Claim 1 and the claims depending therefrom.

Applicants respectfully submit this secondary consideration of “teaching away from” is exactly the type of secondary consideration envisioned by the MPEP to address a *prima facie* case of obviousness.

Withdrawal of the obviousness rejection is respectfully requested.

Applicants respectfully submit the present application is in condition for allowance. Early notification to this effect is earnestly solicited.

Respectfully submitted,

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